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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,136	10/23/2000	Herbert M. Straub	20003	9008
28133	7590	06/02/2006	EXAMINER	
RICHARD L. MARSH 4116 E. LATOKA SPRINGFIELD, MO 65809			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER

1774

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/694,136

Applicant(s)

Straub et al

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed March 20, 2006. Claims 1-4, 11-14 and 20 are amended, rendering claims 1-15, 17-18 and 20 pending in this case.

***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-7, 11-15, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukioka (U.S. 5,733,638).

Tsukioka discloses a hot stamped material comprising a base and inner release layer, which are laminated to the base for coating food wrapping materials (column 2, lines 4-7, 28-44) where the laminate includes a film laminated to a paper support and hot stamp printing on the laminate (column 5, lines 62-67). Tsukioka further discloses the sheet is rolled into a foil, which includes a color layer (column 6, lines 26-30 and column 7, lines 7-10). The hot stamp material comprising a foil transfers to the substrate by means of an adhesive and may be hot stamped on both sides of the material (column 9, lines 41-67) and the material may be rolled (column 13, lines 38-40). Tsukioka discloses the substrate is embossed (column 16, lines 20-25).

***Claim Rejections – 35 USC § 102(b)***

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. (U.S. 5,186,787).

Phillips discloses a hot stamp transfer imaged (inked) foil, carried on a releasable carrier, which is hot stamped onto a substrate, such as paper or film (column 1, lines 8-25, 66-68 and column 2, lines 25-37, 47-64) where the composite is wound upon a roll (column 3, lines 20-21) and comprises a multilayer coating (column 3, lines 23-28). The transferred image on the coating(s) function as being translucent and opaque (column 4, lines 44-50) and an adhesive is placed on the back side of the foil (column 1, lines 22-23).

***Claim Rejections – 35 USC § 103(a)***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. 5,186,787) in view of Boswell (U.S. 5,783,017).

Phillips is relied upon for instant claim 1. Phillips does not disclose an embossed wrapping paper. Boswell teaches a hot stamp transfer imaged (inked) foil, which is hot stamped onto a substrate, such as paper or film, which has adhesive on the back side of the film (column

1, lines 10-21) and an embossed image (column 1, lines 64-65). Phillips and Boswell are both directed to hot stamp transfer foils. Therefore, it would have been obvious to one of ordinary skill in the art to have employed the embossed surface, as taught in Boswell, in the decorative film of Phillips to improve the texture and appearance of the decorative film.

### ***Response to Arguments***

7. Applicant's arguments of rejection made under 35 U.S.C. 102(b) as being anticipated by Tsukioka (U.S. 5,733,638) have been considered but are unpersuasive. Applicant argues there is no limitation disclosing a sheet being beaten or rolled into a foil and no reduction in thickness of any of the materials. Examiner has given the broadest reasonable interpretation of the claims, which is met by Tsukioka. The claims read on a paper decorative wrapping film comprising at least one hot transfer foil on a wrapping paper. Tsukioka discloses a paper decorative material having a hot stamp material comprising a foil, which transfers to the substrate and may be hot stamped on both sides of the material (column 2, lines 4-7, 28-44; column 5, lines 62-67 and column 9, lines 41-67). Additionally, regarding the process of making Tsukioka's hot stamped material, the claims allow for additional components and features, as independent claims 1, 11 and 20 have open language including "a paper decorative wrapping film comprising..." which does not limit the prior art's method of forming a paper decorative wrapping film.

Examiner acknowledges Applicant's comparison of claim 1 and figure 14 of Tsukioka to Applicant's claims 1, 11 and 20. Applicant points to a specific figure and claim and does not take into consideration the entire invention of Tsukioka. Examiner maintains that Tsukioka

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discloses a hot stamped material comprising a base and inner release layer, which are laminated to the base for coating food wrapping materials (column 2, lines 4-7, 28-44) where the laminate includes a film laminated to a paper support and hot stamp printing on the laminate (column 5, lines 62-67). Tsukioka further discloses the sheet is rolled into a foil, which includes a color layer (column 6, lines 26-30 and column 7, lines 7-10). The hot stamp material comprising a foil transfers to the substrate by means of an adhesive and may be hot stamped on both sides of the material (column 9, lines 41-67) where the term "sheet" is considered to be equivalent to Applicant's film. Applicant further argues the substrate of Tsukioka is not embossed, but has an embossed image on the substrate. The substrate of Tsukioka is embossed with an image, resulting in a final product having embossed substrate layer. Applicant is arguing the intermediate steps of the Tsukioka invention, which is the process of making the composite. The actual decorative paper material of Tsukioka meets the limitation of the paper decorative material having an embossed substrate. The rejections over the intended use, capable of and product by process limitations in claims 1-4, 11-14 and 20 have been withdrawn due to Applicant's canceling the intended use, capable of and product by process limitation language in those claims.

Applicant's arguments of rejection made under 35 U.S.C. 102(b) as being anticipated by Phillips et al. (U.S. 5,186,787) have been considered but are unpersuasive. The rejections over the intended use, capable of and product by process limitations in claims 1-4 have been withdrawn due to Applicant's canceling the intended use, capable of and product by process limitation language in those claims. Applicant argues there is nothing in Phillips that says the

finished material is wound on a roll. Phillips discloses the composite is wound upon a roll during the roll-on process (column 3, lines 20-21).

Examiner acknowledges Applicant's comparison of figure 6 of Tsukioka to Applicant's claims 1. Applicant points to a specific figure and does not take into consideration the entire invention of Phillips. Examiner maintains that Phillips discloses a hot stamp transfer imaged (inked) foil, carried on a releasable carrier, which is hot stamped onto a substrate, such as paper or film (column 1, lines 8-25, 66-68 and column 2, lines 25-37, 47-64) where the composite comprises a multilayer coating (column 3, lines 23-28).

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. 5,186,787) in view of Boswell (U.S. 5,783,017) have been considered but are unpersuasive. The rejections over the intended use, capable of and product by process limitations in claims 11-14 have been withdrawn due to Applicant's canceling the intended use, capable of and product by process limitation language in those claims. Applicant argues the decorative structure is embossed after the structure is finished whereas Applicant's layer is already embossed. Boswell teaches an embossed image in the surface of the substrate (column 1, lines 64-65).

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

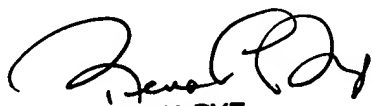
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A.U. 1774 5/30/10